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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,433	06/30/2003	Peter J. Kight	23952-0060	7158

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SUTHERLAND ASBILL & BRENNAN LLP  
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EXAMINER
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LOFTUS, ANN E

ART UNIT	PAPER NUMBER
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3694

MAIL DATE	DELIVERY MODE
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06/19/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/608,433	<b>Applicant(s)</b> KIGHT ET AL.	
	<b>Examiner</b> Ann Loftus	<b>Art Unit</b> 3694	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 13-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-50 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 6/30/2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>2/4/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1-12 are cancelled and 13 through 50 are pending.

### ***Election/Restrictions***

2. Applicant has elected claims 13-16 with traverse. Applicant's election with traverse in the reply filed on 4/9/07 is acknowledged. The traversal is lacking grounds. It is not persuasive because no argument was made. Note MPEP 818.03 (a). The examiner considers the election and amendments to the claims as fully responsive to the restriction requirement.

### ***Priority***

3. In the remarks filed 2/2/06, the applicant disclaims priority from US Patent application 09/2500711. The applicant claims priority from a continuation in part of application 09/795314, which is a division of 09/034561, filed 3/3/98. The latter has become US Patent No. 6289322.

### ***Drawings***

4. The drawings are objected to because of the following informalities. Some of these could be corrected either by changing the specification or the drawing, as long as the references are aligned.

- Figure 3 shows item 430, a telephone. On page 18, [0068] the item is referred to as 330. On page 43 [0137] it is referred to as 430.
- Figure 8 shows item 820c. Page 30 [0099] and page 31 [0105] refer to it as 820a.
- Figure 10A shows item 1020c. Page 34 [0115] refers to it as 1020a.
- Figure 15 shows item 15095. Page 39 [0125] refers to it as 1505.
- Figure 17 shows an item 1736 labeled "make payment". Page 43 [0137] says it is a Payment Date Editor.
- Several figure numbers are hand-lettered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

5. Claims 16 and 38 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

As to claim 16, the parent claim 13 includes the limitation "generating remittance advice based on the received payment instruction," the payment instruction being for the bill. Claim 16 adds "the remittance advice is generated based on the received payment instruction for the bill." It is not clear what claim 16 adds to claim 13.

As to claim 38, the parent claim 32 includes "generate remittance advice based on the received payment instruction" and claim 38 adds ""the remittance advice is generated based on the received payment instruction for the bill." Again, the distinction is not apparent.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 13-50 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claims 13 and 32, the term “remittance advice” is used in the art for payment messages that initiate funds transfer (also called payment instructions) and those that do not. While the embodiment detailed in the specification discusses a remittance advice that is separate from the transfer of funds - it merely serves to provide notice of the funds transfer rather than initiate it – the specification also expressly indicates that other embodiments are included in the invention. The claims refer to remittance advice based on the payment instruction, and do not indicate the distinction. The examiner is compelled to give the broadest reasonable interpretation in light of the specification, thus examination will not observe the distinction with the current claim language. Examination will presume a broad meaning of “remittance advice” to include payment messages.

As to claims 19 and 37, normalizing bill data could refer to normalization with respect to currency or billing period or database normalization. While database normalization is old and well-known, the degree of normalization required to produce “normalized” data is not defined. Business data is seldom normalized to the full extent possible. Which normal form is required in order to call the data normalized? The metes and bounds of the claim are not clear, thus the claims are rejected.

The remaining claims inherit the limitations of the parents, and are thus also rejected.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 13-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No 5699528 filed 31 Oct 1995 by Hogan, and further in view of US Patent No. 5920847 filed Oct 7, 1996 by Kolling et al.

As to claims 13 and 32, Hogan teaches in col 6 lines 20-30 transmitting, to a subscriber by an electronic bill presentment and payment service provider supporting multiple billers and multiple subscribers, bill presentment information representing a bill from a biller for the subscriber. Hogan teaches in col 6 lines 30-64 receiving a payment instruction for the bill from the subscriber for payment. Hogan teaches in Claim 18 transmitting the remittance advice to the biller. Hogan does not specifically teach generating the remittance advice. Kolling teaches generating remittance advice (payment message) in col 29 line 42. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Hogan to include generating the remittance advice because if the billing service generates the remittance advice, they can put their logo and advertising with it.

As to claims 14 and 33, Hogan teaches generating the bill presentment information based on original bill information representing the bill in Figure 4, and described in col 6.

As to claims 15 and 34, Hogan teaches the generated bill presentment information including a summary of the bill represented by the original bill information in Figure 4, and described in col 6.

As to claims 16 and 38, see above regarding generating remittance advice.

As to claims 17 and 35, Hogan teaches in col 4 lines 53-60, the original bill information received from the biller.

As to claims 20 and 39 Hogan teaches in col 6 lines 30-65 transmitting a presentation of a payment request screen, wherein the payment request screen includes at least a portion of the information associated with the bill from the biller.

As to claims 21 and 40, Hogan teaches a payment request summary with the name of the biller, an amount of the bill and a due date for payment of the bill in col 10, lines 52-59. Hogan teaches information with the payment request including name of the biller and amount of the bill in Figure 4. Hogan teaches including the due date with payment request information as a screen default in col 11 lines 37-48.

As to claims 22 and 41, Hogan teaches transmitting a payment associated with the payment instruction in col 8 lines 39 to 62.

As to claims 23, 24, 42 and 43, Hogan teaches an electronic payment in col 8 lines 39 to 62, including remittance advice. Hogan does not specifically teach a check payment by a billing service. Kolling teaches a payment by check in col 7 line 52 to col 8



line 4, including remittance advice. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Hogan to include a billing service making a payment by check because some merchants prefer to be paid by check, and that would allow the service to accommodate more merchants.

As to claims 25 and 44, Hogan teaches a remittance advice transmitted to the biller via financial institution associated with the biller in col 8 lines 24-63, and figure 5.

As to claims 26 and 45, Hogan does not specifically teach a consolidated remittance advice. Kolling teaches in col 7 line 52 to col 8 line 4 a consolidated remittance advice based on payment instructions from more than one subscriber. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Hogan to include a consolidated remittance advice because it simplifies the processing for the recipient of the advice.

As to claims 28 and 47, Hogan teaches multiple subscribers who each see their own bills in col 5 lines 2-4, and protection against unauthorized access in col 5 lines 45-53. In Figure 4, and described in col 6, Hogan teaches transmitting to a subscriber electronic bill presentment information representing a bill. Thus for the second of the multiple subscribers, Hogan teaches transmitting to a second subscriber electronic bill presentment information representing a second bill.

As to claims 29-31 and 48-50, Hogan does not specifically teach transmitting a consolidated payment by check with a consolidated remittance advice. Kolling teaches transmitting a consolidated payment by check with a remittance advice in col 7 line 52 to col 8 line 4. It would have been obvious to a person of ordinary skill in the art to

modify Hogan to include consolidated payment by check with a consolidated remittance advice because consolidation simplifies processing and because merchants accept checks and because transmitting them together helps the recipient crosscheck the payments claimed in the advice against the sum received.

9. Claims 18 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan in view of Kolling and further in view of US Patent No 5220501 filed 8 Dec 1989 by Lawlor et al.

Hogan teaches bill presentment information generated for presentation from the original bill information in Figure 4. Hogan does not teach generating the presentment information from a template. Lawlor teaches a template for generating a presentation of bill information in col 37 line 65 to col 38 line 65. It was old and well-known at the time of the invention to generate a presentation screen from a template as Lawlor teaches. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the Hogan Kolling combination to include generating bill presentment information from the original bill information with a template because templates enable efficient storage of a particular reusable format, as opposed to storing an individualized format for each bill. Templates allow quick assembly of pieces of data into a coherent design, and re-use of the design allows users to gain familiarity with it.

10. Claims 19 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan in view of Kolling and further in view of an article by Wu from the

Association for Computing Machinery dated 1992 and titled "The Practical Need for Fourth Normal Form."

Hogan teaches original bill information in col 4 lines 53-60. Hogan does not specifically teach normalized information. Wu teaches normalizing information in the left column of page 19, in the Introduction. Wu is addressing efficient database techniques used on any large collection of data to reduce size and improve update efficiency and accuracy. A person of ordinary skill in the art of billing systems would find it obvious to use a reference on efficient database techniques to help set up the databases involved in the billing system in order to take advantage of the latest techniques for reducing the storage requirements and increasing update efficiency and accuracy. It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the Hogan Kolling combination to include normalizing original bill information in order to reduce storage requirements and increase update efficiency for the data in the billing system.

11. Claims 27 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan in view of Kolling and further in view of Official Notice.

As to claims 27 and 46, Hogan does not specifically teach a consolidated remittance advice. Kolling teaches in col 7 line 52 to col 8 line 4 a consolidated remittance advice based on payment instructions from more than one subscriber. Kolling teaches a check and list, but does not specifically say the list is printed. Official Notice is taken that printing business correspondence is old and well-known. It would

have been obvious to a person of ordinary skill in the art at the time of the invention to modify the Hogan Kolling combination to include a consolidated remittance advice that was printed, because a printed list takes no special equipment, and can be read by any biller.

### ***Conclusion***

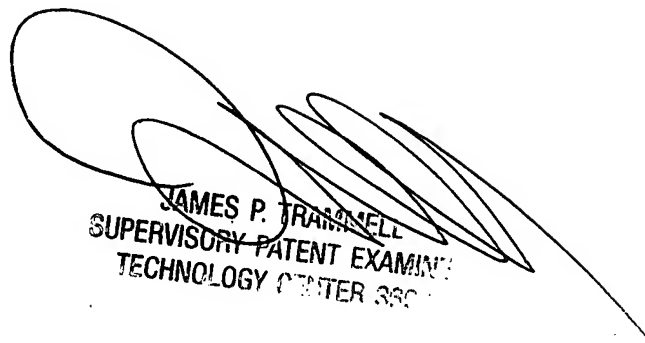
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ann Loftus whose telephone number is 571-272-7342. The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AL

6/11/07



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